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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/894,734	06/28/2001	Jack L. Leonard	07917-103001 / UMMC 99-45	9864

7590 10/09/2002
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EXAMINER

CROUCH, DEBORAH

ART UNIT PAPER NUMBER

1632

DATE MAILED: 10/09/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/894,734

Applicant(s)

LEONARD ET AL.

Examiner

Deborah Crouch

Art Unit

1632

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-49 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☐ Claim(s) ____ is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☒ Claim(s) 1-49 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____
- 4) ☐ Interview Summary (PTO-413) Paper No(s) ____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-24 and 26-37, drawn to a method of cloning a mammal by nuclear transfer using a fibroblast as the nuclear donor and the cloned mammal, classified in class 800, subclass 24.
- II. Claims 1-24, 26-29, 32, 33, 36 and 37, drawn to a method of cloning an amphibian by nuclear transfer using a fibroblast as the nuclear donor and the cloned amphibian, classified in class 800, subclass 24.
- III. Claims 1-24, 26-29, 32, 33, 36 and 37, drawn to a method of cloning a fish by nuclear transfer using a fibroblast as the nuclear donor and the cloned fish, classified in class 800, subclass 24.
- IV. Claims 1-24, 26-29, 32, 33, 36 and 37, drawn to a method of cloning a bird by nuclear transfer using a fibroblast as the nuclear donor and the cloned bird, classified in class 800, subclass 24.
- V. Claims 1, 24 and 25, drawn to a method of cloning an animal by nuclear transfer using a fibroblast as the nuclear donor and inserting a reagent into the cytoplasm, and a method for modulating embryological development, classified in class 800, subclass 24.

The inventions are distinct, each from the other because:

Each of Inventions I-IV are mutually exclusive and independent. Inventions I-IV are to methods of cloning, by nuclear transfer, a mammal, an amphibian, a fish and a bird, respectively. Nuclear transfer methods in each of these species require materially different and separate protocols. Further, none of inventions I-IV are required for the implementation of each other.

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Inventions I-IV and V are distinct from one another. Inventions I-IV can be used to clone an animal. Invention V can be used to alter embryonic development or to observe embryonic development.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Deborah Crouch, Ph.D. whose telephone number is (703) 308-1126. The examiner's SPE is Deborah Reynolds, whose telephone number is (703) 305-4051.

Any inquiry of a general nature or relating to the status of this application should be directed to the Art Unit Patent Analyst, Pauline Farrier, whose telephone number is (703) 305-3550.

The fax number is (703) 308-4242.

Dr. D. Crouch
September 27, 2002



DEBORAH CROUCH
PRIMARY EXAMINER
GROUP 1800-1630